

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, claim 3 has been canceled without prejudice or disclaimer to the subject matter recited therein. Applicants reserve the right to file one or more continuation applications directed to the subject matter recited therein. Additionally, new claims 10 and 11 have been added. Support for new claims 10 and 11 can be found throughout the present application. In particular, support for claim 10 can be found on at least page 6, lines 11-14 of the originally-filed application. Support for claim 11 can be found for instance in original claim 3.

Turning now to the Office Action, claims 1-4, 8 and 9 have been rejected under 35 U.S.C. § 102(b) as purportedly being anticipated by Babayan (U.S. Patent No. 3,450,819). This rejection is respectfully traversed.

The Federal Circuit has held that for prior art to be anticipatory, every element of the claimed invention must be disclosed, either literally or inherently, in the form defined in the claim. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 213 U.S.P.Q. 81, 90 (Fed. Cir. 1986). This requirement for anticipation has clearly not been met with respect to the pending claims of the present application.

Claim 1, for example, calls for a medium chain triglyceride which is defined by the following three features: (i) 90% by mass or more of fatty acids constituting medium chain triglycerides are comprised of saturated fatty acids having 8 and 10 carbon atoms, (ii) the ratio by mass of the saturated fatty acids having 8 carbon atoms to the saturated fatty acids having 10 carbon atoms is 60:40 to 85:15, and (iii)

the saturated fatty acids having 8 carbon atoms is present in an amount of 60 to 85% by mass of the total fatty acids bonded to the triglycerides at the 2-position.

On the other hand, Babayan discloses a mixture of cod liver oil and capric-caprylic glyceride at Example 8, as the Examiner indicated. However, Example 8 of Babayan is silent with respect to feature(s) (ii) and (iii) of the present invention. Example 4 in Babayan does not remedy the serious deficiencies of Example 8.

Since every element of the claimed invention is not disclosed by the Babayan patent, such patent cannot and does not anticipate applicants' pending claims. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-9 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable of Babayan (U.S. Patent No. 3,450,819) in view of Paparnandjaus et al.. This rejection is respectfully traversed.

As described above, Babayan does not disclose nor suggest the medium chain triglyceride used in the present invention. The Paparnandjaus et al. reference fails to remedy the serious deficiencies of the Babayan patent.

In addition, as a regulator, the present invention not only decreases the body weight but also increases the body weight. See, e.g., page 9, line 19 to page 10, line 10 of the present application. The Examiner states that the Paparnandjaus et al. reference treats obesity and thus it would have been obvious to use the Babayan composition as a fat regulator. However, a teaching for treatment of obesity would not have suggested to one of ordinary skill in the art to increase body weight. None of the cited documents teach or such a function which decreases and increases the body weight.

Moreover, the Babayan patent does not disclose nor suggest that the body-fat controlling function appears by specifying the content of medium chain triglyceride in an agent, the kinds and proportions of fatty acid residues constituting the medium chain triglyceride and the bonding positions of the fatty acid residues.

Therefore, even if the Babayan patent were combined with the Paparnandjaus et al. reference, one of ordinary skill in the art would not have arrived at applicants' claimed invention. As such, applicants' claims can not have been considered to have been obvious over the prior art at the time of their invention. Accordingly, withdrawal of this obviousness rejection is respectfully requested.

Claim 9 has also been rejected under 35 U.S.C. § 103(a) as being unpatentable over the following combination of references: (a) over Seiden (U.S. Patent No. 5,288,512) in view of Babayan (U.S. Patent No. 3,450,819), and (b) over Menz (U.S. Patent No. 3,658,555) in view of Babayan (U.S. Patent No. 3,450,819). Both of these rejections are respectfully traversed.

The Examiner has indicated that the Seiden and Menz patents disclose products that contain MCT. While acknowledging that claim 9 differs from the Seiden and Menz patents by not disclosing a regulator which comprises the particular medium chain triglyceride as set forth in claim 1, the Examiner has asserted that the Babayan patent teaches the particular medium chain triglyceride as set forth in claim 1. However, as described above, the Babayan patent does not disclose nor suggest the medium chain triglyceride used in the present invention.

Hence, even if the disclosure of the Seiden patent or the disclosure of the Menz patent were combined with the Babayan patent, the skilled artisan would not achieve applicants' claimed invention. As such, proper *prima facie* cases of

obviousness have not been established. The Examiner is thus requested to withdraw both of these obviousness rejections.


In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited

In the event that there are any questions relating to this Amendment and Reply, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: 
Susan M. Dadio
Registration No. 40,373

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620